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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,494	08/09/2001	Junji Machida	325772026400	2609

7590 06/06/2003
MORRIS & FOERSTER LLP
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EXAMINER

BRASE, SANDRA L

ART UNIT	PAPER NUMBER
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2852

DATE MAILED: 06/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/924,494

Applicant(s)

MACHIDA ET AL.

Examiner

Sandra L. Brase

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 6-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 6-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper No. 6.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-5, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Machida et al. (US 5,875,379) in view of Kasuya et al. (US 5,571,653).

Machida et al. (...379) disclose a developing device comprising: a developer carrying member (11) having a rubber hardness of 20 to 70 degrees (abstract; col. 2, lines 40-57; col. 3, lines 50-55; col. 8., lines 29-39; and col. 8, lines 51-60), an elongation of 400 to 1200 % (abstract; col. 2, lines 40-57; col. 3, lines 50-55; col. 8., lines 29-39; and col. 8, lines 51-60), and a volume electrical resistance of 10^3 to 10^{15} Ω cm at its surface (col. 4, lines 57-61); a storage portion (figure 4) for storing a toner (2) to be supplied to the developer carrying member; and a regulating member (16) disposed in contacting relation with the surface of the developer carrying member for regulating the amount of toner carried on the developer carrying member (col. 8, lines 40-44). The developer carrying member comprises a metallic roller and a surface layer laid over an outer periphery of the roller (figure 4). However, Machida et al. (...379) do not disclose the claimed type of toner. Kasuya et al. (...653) disclose a toner used in a developing device containing an organic aromatic solvent and a vinyl monomer in combined concentrations of not more than 1,000 ppm (abstract; col. 2, line 50 – col. 3, line 15; col. 9, line 29-36; and Table 2), where it is preferable that the combined concentrations be made not more than 700 ppm, and more preferably not more than 300 ppm (col. 9, lines 29-36). The toner has an average particle size of 8.1 or 8.2 μm (Table 1) in which the toner particles 4 μm or less in size are present in concentrations of 14.0, 14.2 or 14.5% in terms of percentage of particle count (Table 1), hence toner particles of 3 μm or less in size are present in concentrations equal to or less than 14.0, 14.2 or 14.5% in terms of percentage of particle count. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the claimed type of toner in the developing device since such a toner is well known in the art for use with a developing device, as disclosed by Kasuya et al. (...653), to develop electrostatic latent images.

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5. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Machida et al. (US 5,875,379) in view of Kasuya et al. (US 5,571,653) as applied to claim 1 above, and further in view of Shimojo et al. (US 5,436,701).

Machida et al. (...379 in view of Kasuya et al. (...653) disclose the features mentioned previously, and Kasuya et al. (...653) disclose the toner contains a binder resin (abstract); however, they do not disclose performing vacuum drying. Shimojo et al. (...701) disclose a toner containing a binder resin (abstract), and vacuum drying is performed for preparing the binder resin (col. 13, lines 41-60). It would have been obvious to one of ordinary skill in the art at the time of the invention to perform vacuum drying, as disclosed by Shimojo et al. (...701) so as to remove a solvent.

Final Rejection

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Response to Arguments

7. Applicant's arguments filed 3/20/03 have been fully considered but they are not persuasive.

8. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the references is that Kasuya et al. (US 5,571,653) disclose a toner that is made so that it is capable of developing electrostatic images, where the developing device in Machida et al. (US 5,875,379) is implemented to develop an electrostatic latent image by the use of a toner, hence it would have been obvious to one of ordinary skill in the art at the time of the invention to use the toner composition of Kasuya et al. (...653) in the developing device of Machida et al. (...379) for the development of electrostatic latent images since the toner composition is well known in the art, as disclosed by Kasuya et al. (...653) to be capable of developing electrostatic latent images.

Contacts \ Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra L. Brase whose telephone number is (703) 308-3101.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur T. Grimley, can be reached on (703) 308-1373. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3431 or 305-3432.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Sandra L. Brase
Primary Examiner
Art Unit 2852

June 5, 2003